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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,384	04/30/2004	Anders Eriksson	00173.0053.PCUS00	1681

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EXAMINER

HO, HA DINH

ART UNIT PAPER NUMBER

3681

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/709,384

Applicant(s)

ERIKSSON ET AL.

Examiner

Ha D. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/30/04 & 9/01/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is the first Office Action on the merits of Application No. 10/709,384 filed on 04/30/04. Claims 1-9 are currently pending.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because of exceeding 150 words in length. Correction is required. See MPEP § 608.01(b).

Claim Objections

4. The claim 1 is objected to because they include reference characters which are not enclosed within parentheses (see claim 1, line 18).

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

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5. Claims 8 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Note that claims 8 and 9 are multiple dependent claims depending from a multiple dependent claim 6.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 3 and 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 2, line 2, “the free wheel function” lacks antecedent basis.
- Claim 2, lines 5, 6, 7, 8 and 9, the recitations of “activated free wheel function” constitute double inclusions since “an activated free wheel function” was previously recited in claim 2, line 4.
- Claim 3, lines 3-4, the recitation of “activated free wheel function” constitutes a double inclusion since “an activated free wheel function” was previously recited in claim 2, line 4.
- Claim 5, lines 4-5, the recitation of “a position” constitutes a double inclusion since “a position” was previously recited in claim 4, lines 4-5.

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- Claim 5, line 7, “the above-mentioned interval” lacks antecedent basis.
- Claim 6, line 6, the recitation of “a position” constitutes a double inclusion since “a position” was previously recited in claim 4, lines 4-5.
- Claim 6, line 7, the recitation of “an auxiliary brake” constitutes a double inclusion since “an auxiliary brake” was previously recited in claim 4, lines 5-6.
- Claim 6, line 9, the recitation of “a pre-set upper interval” constitutes a double inclusion since “a pre-set upper interval” was previously recited in claim 4, lines 7-8.
- Claim 7/6/5, line 9, the recitation of “a gear” constitutes a double inclusion since “a gear” was previously recited in claim 5, line 3.
- Claim 7, lines 4-5, the recitation of “a position” constitutes a double inclusion since “a position” was previously recited in claim 4, lines 4-5.
- Claim 8, line 3, “the actual speed” lacks antecedent basis.
- Claim 9, line 3, the recitation of “a gear” constitutes a double inclusion since “a gear” was previously recited in claim 5, line 3.
- Claim 9, line 4, “the clutch” lacks antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1 are rejected under 35 U.S.C. 102(e) as being anticipated by Steen (US 6,869,377).

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Steen'377 teaches a increment shifted transmission (9) for motor vehicles comprising an in-going shaft (7) mounted in a housing (8), at least one intermediate shaft (11) arranged in the housing, which exhibits at least one gear wheel (16) in engagement with a gear wheel (12) on the in-going shaft, a main shaft (10) arranged in the housing with gear wheels (15, 21, 22, 23) which engage gear wheels (17, 18, 19, 20) on the intermediate shaft, with at least one of the gear wheels in each pair of mutually engaging gear wheels on the intermediate shaft and the main shaft being rotatably arranged about its shaft and being, by means of coupling members (13, 24, 25),

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lockable on its shaft, and with maneuvering members (40, 41, 42) which interact with the coupling members and are controlled by a control unit (45) depending on signals fed through the control unit representative of various engine and vehicle data wherein the maneuvering members (40, 41, 42) are arranged to, in the case of in-signals to the control unit (45) which indicate a predetermined driving condition (e.g., when the throttle has a zero throttle value) at which the fuel consumption of the vehicle is optimally low (at zero throttle value, the fuel consumption of the vehicle is low), be set by means of the control unit (45) so that a synchronized gear which is engaged at the time is set in neutral position (see col. 2, lines 1-3), and in that the maneuvering members (40, 41, 42) are arranged to deactivate said neutral position when said driving condition is no longer present (see col. 2, lines 3-7).

Regarding claims 2, 3 and 6, see col. 4, lines 1-16.

Regarding claims 4, 5 and 7, see col. 2, lines 1-7.

Regarding claims 8 and 9, see col. 4, lines 17-38.

Cited Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Yamamoto et al.'643, Steeby et al.'628, Matsufuji'827, Steen'377 and Rletach'247 which each shows a countershaft transmission including synchronizers.

Communication

11. Submission of your response by facsimile transmission is encouraged. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by

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facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
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Typed or printed name of person signing this certificate:

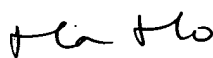
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ha D. Ho whose telephone number is **571-272-7091**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on **571-272-7095**.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HDH
(571) 272-7091
October 31, 2005


HA HO
PRIMARY EXAMINER
Art Unit 3681

10/31/05